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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,987	03/19/2001	Bernd Bruchmann	12075	9596

28484 7590 07/15/2004

BASF CORPORATION
LEGAL DEPARTMENT
1609 BIDDLE AVENUE
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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/811,987	Applicant(s) BRUCHMANN ET AL.	
	Examiner Rabon Sergent	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 23, 2004 has been entered.
2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language, "... a high functionality polyisocyanate prepared as claimed in claim 10", renders the claim indefinite, because claim 10 is not drawn to a process for preparing the polyisocyanate. Claim 10 is merely drawn to the polyisocyanate.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 2, and 4-13 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bauriedel ('709) or Bolte et al. ('164).

Patentees disclose methods for producing polyurethane prepolymers, wherein the methods encompass reacting a diisocyanate having isocyanate groups with differing reactivities with a polyol, including triols, to yield a product having both isocyanate functionality and isocyanate reactive functionality, including single hydroxyl functionality, which is then reacted with another diisocyanate. Despite applicants' arguments, patentees disclose preferred ratios of initial hydroxyl groups to initial isocyanate groups which will yield applicants' claimed addition product (A). See abstract and columns 2-5, especially column 5, line 4 within Bauriedel. See abstract and columns 2-4, especially, column 4, lines 21 and 22 within Bolte et al. The position is taken that when the disclosed trifunctional or higher polyols are used at the disclosed ratios, the disclosed processes anticipate applicants' process and high-functionality polyisocyanate.

5. However, if it is determined that the references fail to be anticipatory due to the fact that diols are also disclosed, the position is taken that it would have been obvious to one seeking

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increased functionality isocyanates to utilize the disclosed increased functionality polyols, while operating within the disclosed preferred index ratio range.

6. The examiner has considered applicants' response of May 28, 2004; however, the response is deficient for the following reasons. Firstly, with respect to arguments concerning the references' disclosed use of diols, the examiner has addressed this issue within paragraphs 4 and 5. As aforementioned, the references disclose the use of polyols, including triols; therefore, it is not seen that arguments pertaining to the use of diols are effective to patentably distinguish the instant claims from the prior art. Secondly, applicants' argument concerning the ratio of Bauriedel at page 11 of the response is not understood. Applicants have stated that a OH to NCO ratio of 3:4 is outside the range disclosed by Bauriedel; however, the ratio, 3:4, is simply 0.75:1, and this ratio clearly falls within the reference's disclosed ratio of 0.55-4:1. Lastly, the examiner has considered applicants' argument with respect to Bolte et al. always having free OH groups; however, given the instant claim language, it is by no means clear that applicants' claims preclude the argued polyisocyanates of Bolte et al. Applicants' claims do not set forth a ratio of isocyanate reactive groups within product (A) to isocyanate groups within diisocyanate or polyisocyanate II; therefore, the position is taken that the claims allow for a less than equivalent quantity of isocyanate groups relative to the isocyanate reactive groups. Given such a scenario, a reaction between the isocyanate reactive groups of product (A) and the diisocyanate or polyisocyanate II would still occur to some extent and polyisocyanates having at least three isocyanate groups would still result. Applicants' claims are not considered to preclude the presence of a final product having a content of isocyanate reactive groups.


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7. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent

July 10, 2004


RABON SERGENT
PRIMARY EXAMINER